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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,246	06/16/2006	Fraser Wardrop	P03179	9110
23702 7590 03/03/2009 Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604-2701				
EXAMINER				
DYE, ROBERT C				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/583,246

**Applicant(s)**

WARDROP ET AL.

**Examiner**

ROBERT DYE

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 16 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-4, drawn to a method for releasing a lens by raising a pin which is located in a pallet via an anvil and pressing with an annulus pressing means.

Group II, claim(s) 5-7, drawn to a method for simultaneously processing lenses through a process station for release, inspection and transfer.

Group III, claim(s) 8-10, drawn to a lens pallet including an axially movable pin.

2. The inventions listed as Groups I, II, and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

3. The technical feature of Group I comprises a method for releasing a lens from a mold via the combined forces of a pin axially located on the non-optical surface side of the lens mold and an annulus pressing means.

Group II and Group III lack this technical feature. Group II comprises a series process stations in an annular array for the simultaneous processing of lenses. Group III is drawn to a lens pallet with an axially movable pin but does not comprise the feature of a lens release head having an annulus which is essential for carrying out the invention of Group 1.

Further, the presence of an axially movable pin in the lens pallet can not be considered a special technical feature in view of prior art US6,558,584 which discloses a lens pallet and release mechanism with an axially located pin (see pin 28 in figure 9A).

Thus there are no special technical features linking the three groups of inventions.

4. During a telephone conversation with Jack Thomas on 2/18/2009 a provisional election was made with traverse to prosecute the invention of Group I, claim1-4.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 5-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill et al. (USP 6,558,584) in view of Lesczynski et al. (USP 6,428,723).

10. Regarding claim 1, O'Neill et al. (hereinafter O'Neill) teach a method for releasing a lens from an associated mold section in which a lens was formed and adhered. Said mold contains an optical surface 12A, a non-optical surface opposite the optical surface, annular shoulder 12E and annular wall 12C (see figure 1A). O'Neill teaches that the method comprises the steps of providing an axially movable pin contacting the non-optical surface of the mold section located opposite the lens (see pin 28 in figure 9A and

9B); raising the pin to a stationary position such that the annular wall is not directly supported (see figure 9B wherein wall is not supported); providing a lens release head with an annulus (see plate 58); and pressing the lens release head and annulus on top of the mold section within predetermined load parameters with the annulus engaging the upper shoulder of the mold section while the non-optical surface of the mold section remains seated on the said stationary pin (see col 9, lines 49-63 – the action of the pin 29 in contact with the non-optical surface of the mold causes a force, or pressing, between the mold and the plate 58); whereby the mold section is deformed and the lens is released from the mold section (col 9, lines 61-62).

11. The prior art invention differs from the present invention in that the method of O'Neill achieves deformation of the contact lens mold by active pressing of the pin against the mold rather than the annulus of the lens release head. In the same field of endeavor of deforming contact lens molds, Lesczynski teaches a method wherein a pin and annulus cooperate to exert counteractive forces to deform a contact lens mold; in particular, Lesczynski teaches that the mold deformation can be achieved either through active pressing of annulus (see figure 8 with cylindrical member 80 and stationary pin 87, col 6, lines 19-25) or through active pressing of the pin (see figure 7 with pin 77 and stationary outer annulus, col 5, lines 43-45). Lesczynski teaches that active pressing of the annulus with stationary pin produces an equivalent deformation of the lens mold as active pressing of the pin (col 6, line 24-25; col 5, lines 47-49). It would have been obvious to a person having ordinary skill in the art at the time of the invention to employ active pressing of the annulus with stationary pin against the lens mold in the method of

O'Neill for the purpose of achieving the equivalent effect of lens mold deformation as taught by Lesczynski.

12. Regarding claim 2 wherein the lens head movement and the load parameters are controlled and programmed with a servo drive assembly, O'Neill teaches that the while the amount of mold deflection is deemed to be the primary parameter of concern for safe lens release from the mold section, the pressing force and duration of engagement are also important parameters to consider (col 10, lines 9-19). While O'Neill does not explicitly state the use of a servo drive assembly, servo drives are well known in the art as a means to actuate movement of a molding device and it would have been obvious to a person having ordinary skill in the art to use an automatic and programmable servo drive to control the release head movement such as to maintain the pressing force and duration of engagement within operational tolerances.

13. Regarding claim 3, O'Neill does not teach the type of article used to cause the movement of the pin, particularly the use of an anvil. However, a person having ordinary skill in the art would recognize that said pin would require an object of sufficient strength and size to cause movement of the pin and sustain the desired pressing force against the mold. The instant specification and claims do not describe what constitutes the metes and bounds of the anvil that is claimed. A solid object used to press the pin against the non-optical surface of the mold could be construed as the claimed anvil. It would have been obvious to a person having ordinary skill in the art to provide an anvil

(solid support) in the method of O'Neill to provide the pin with axial movement and support against the pressing force as the lens mold is engaged for lens release.

14. Regarding the use of a pallet moved along a conveyor, O'Neill describes the use of a pallet but does not explicitly state that said pallet is moved along a conveyor.

However, conveyors are a well known means for transporting pallets along a production line and further O'Neill describes a conveyor as a known transport system for use in transporting the pallet covers (col 7, lines 41-42). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a conveyor system in the method O'Neil for the purpose of efficiently and automatically transporting the lens pallets between processing stations.

15. Regarding claim 4, O'Neill teaches that lens pickup heads pick up the released lens from its associated mold section through a hole formed in the lens release head and annulus (see figures 9B and 9C).

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wood (USP 4,909,969), Nakabayashi (USP 6,908,575), Beebe et al. (PGPub US2007/0138670).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT DYE whose telephone number is (571)270-7059. The examiner can normally be reached on Monday to Friday 8:00AM to 5:00 PM EST.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph S. Del Sole can be reached on (571)272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RCD

/Joseph S. Del Sole/  
Supervisory Patent Examiner, Art Unit 1791